

II. REMARKS

In response to the requirement for restriction under 35 U.S.C. 121 and 372, mailed July 17, 2002, Applicants elect, with traverse, Group IV, consisting of Claims 14-23 and 28-29, drawn to methods for identifying modulators of signal transduction using a cell-based array. Given the election with traverse of Group IV, Applicants elect with traverse a GPCR, as the species of signal transduction molecules. Applicants have canceled claim 19 without prejudice and amended claim 20. After entry of the amendment, claims 14-18, 20-23, and 28-29 will be pending and under consideration. The amendment to claim 20 does not add new matter since it corrects typographical errors and the changes the dependency in response to the cancellation of claim 19.

The restriction notes that should Group IV be elected, further restriction to a species is required. The Action notes that claims 14-23 and 28-29 are generic to a plurality of disclosed patentably distinct species. In view of cancellation of claim 19, the species election is moot with respect to the specifically named signal. The restriction requirement is traversed with respect to the signal transduction species requirement. Applicants submit that a search relevant to the method of Group IV would identify references relevant to all of the signal transduction proteins recited in claim 20. Therefore, it would not constitute an undue burden to examine all the signal transduction proteins of claim 20. As indicated in MPEP § 803.02 where members of a Markush group are sufficiently few in number or so closely related that a search and examination of the entire claim can be made without serious burden, the examiner must examine all the members of the Markush group together, even though they may be directed to independent and distinct inventions.

In fact, examining together methods using the signal transduction proteins of claim 20, would prevent a duplicative effort on the part of the U.S. Patent and Trademark Office. Searching any one of the members of the Markush group of claim 20, would result in identifying art related to any members of the group. Therefore, independent searches related to either species, would identify similar if not identical art. Applicants request that once the generic claim is found to be allowable, all of the remaining species be added back to claim 20, per MPEP 806.04(d):

MPEP 806.04(d) regarding Definition of a Generic Claim.

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For the purpose of obtaining claims to more than one species in the same case, the generic claim cannot include limitations not present in each of the added species claims. Otherwise stated, the claims to the species which can be included in a case in addition to a single species must contain all the limitations of the generic claim. Once a claim that is determined to be generic is allowed, all of the claims drawn to species in addition to the elected species which include all the limitations of the generic claim will ordinarily be obviously allowable in view of the allowance of the generic claim, since the additional species will depend thereon or otherwise include all of the limitations thereof.

In view of the amendments and the above remarks, it is submitted that the claims are in condition for allowance and a notice to that effect is respectfully requested. The Examiner is invited to contact Applicant's undersigned representative if there are any questions relating to this application. Please charge any additional fees, or make any credits, to Deposit Account No. 50-1355.

Respectfully submitted,

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Enclosure: Exhibit A

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EXHIBIT A

MARKED-UP COPY OF THE CLAIMS SHOWING THE AMENDMENTS

In the Claims

Please cancel claim 19 without prejudice.

Please amend claim 20 as follows:

20. (Amended) The method of claim [19] 18, wherein said signal transduction protein is heterologously expressed and is [selected from the group of a kinase, a phosphatase,] a G-protein coupled receptor (GPCR) [, a tyrosine kinase receptor, a tyrosine phosphatase receptor, an ion channel, a G-protein, a phospholipase, and or a calcium binding protein].